

BEST AVAILABLE COPY

Applicants respectfully traverse the outstanding rejection of Claim 18 under 35 USC §112, 2<sup>nd</sup> para., as being indefinite because the recitation of "said tubular mouthpiece" in Claim 18 finds clear antecedent basis in Claim 17, at line 5, in the recitation of "a tubular mouth-piece mounted in front of the first microphone capsule . . ." Reconsideration and withdrawal of this ground for rejection is respectfully requested.

Applicants further respectfully traverse the several grounds for rejection on the merits on the basis that the applied Kettl et al patent clearly does not obviate the claimed structure. In particular, Claim 17 states that the mouth-piece is tubular and is mounted in front of the first microphone capsule with the microphone capsule positioned between the flexible cap and the mouth piece. In contrast, the outstanding Office Action relies on the sleeve 12 of the Kettl et al as corresponding to the recited mouthpiece. However, as disclosed at column 4, lines 38-39, the sleeve 12 is not a mouthpiece, but part of "a microphone mounting structure 2 comprising a tubular plug 10, ... sleeve 12, and tubular locking mechanism 14." As further disclosed at column 4, lines 61-64, "the sleeve 12 preferably has an internal diameter which matches the outer diameter of the microphone 4 so that the microphone remains frictionally retained with the sleeve 12." As understood from Kettl et al's Figures 2 and 4, the microphone 4 is concentrically disposed within the sleeve 12. As such, the sleeve 12 has no speech channeling and noise baffling functions and performs no such functions. Therefore, it is respectfully submitted that the sleeve 12 clearly does not meet the "tubular mouthpiece" feature recited in Claim 17.

Reiterating, the Kettl et al patent clearly does not disclose "a tubular mouth-piece mounted in front of the first microphone capsule with the microphone capsule positioned between the flexible cap and the mouth-piece" as stated in Claim 17. If the Kettl et al sleeve 12 is construed as a "mouthpiece," as stated in the outstanding rejection, the sleeve 12 is not "mounted in front of the first microphone capsule with the microphone capsule positioned

BEST AVAILABLE COPY

between the flexible cap and the mouth-piece." Thus, it is respectfully submitted that Kettl et al disclose no structure whereby a voice channeling and noise baffling path to the microphone is achieved, as is achieved according to the claimed invention. It is therefore respectfully submitted that the outstanding rejection of Claim 17 is traversed and further respectfully requested that this ground for rejection be withdrawn.

Claim 18 is directed to the dimensioning of the mouth-piece, whereby speech is channeled from the location at which the lips of a user are adapted to be located to the microphone capsule. New Claim 18 indicates that the opening of the mouthpiece at the distal end adjacent the location where the mouth of a user is adapted to be placed is larger than an opening at an end of the mouth-piece facing the microphone capsule, as is readily evident from the disclosure shown in Figure 2, for example. This structure is believed advantageous both for channeling speech to the microphone capsule and blocking out noise otherwise existing in the flexible cap of the claimed breathing mask. The outstanding Office Action recognizes this deficiency in Kettl et al but relies on the Boinberger mouthpiece 9, 14 as remedying this deficiency. However, the analysis presented at page 7 of the outstanding Official Action fails to state any motivation in the references themselves for making this combination, and ignores the explicit teaching in Kettl et al that "the sleeve 12 preferably has an internal diameter which matches the outer diameter of the microphone 4 so that the microphone remains frictionally retained with the sleeve 12." To modify the sleeve 12 to be "a tubular month-piece [which] has an opening at said distal end larger than an opening facing the microphone capsule" as claimed, even assuming such structure is evident according to the microphone of Boinberger, would defeat the utility of the sleeve as a microphone mounting structure, as explicitly disclosed in the Kettl et al patent.. Accordingly, it is respectfully submitted that the outstanding rejection of Claim 18 is likewise traversed and it is requested that this ground for rejection also be withdrawn.

BEST AVAILABLE COPY

Applicants further challenge the taking of judicial notice with respect to the outstanding rejection of Claim 10 as obvious over Kettl et al. In the absence of a clear teaching in the prior art, i.e., "substantial evidence," it is respectfully submitted the Claim 10 which defines that the aperture of the mouth-piece is elliptical with a greatest dimension of the ellipse extending laterally toward the sides of the mask, is in no way obvious. This is also true of the metal lattice screen stated in Claim 12, and the second microphone capsule of Claim 16 for which judicial notice was also taken. Once again, in the absence of a clear teaching in the prior art with respect to each structural feature for which judicial notice has been taken, there is no "substantial evidence" in support of the rejection. It is therefore respectfully submitted that the burden under 35 USC §103 has not been satisfied and the rejections of Claims 10, 12 and 16 are traversed.

Claim 13 further limits the mask of Claim 17 as including "a baffle fixedly joined to the flexible cap and positioned between the first microphone capsule and the exhalation port." The outstanding Office Action acknowledges that Kettl et al includes no such teaching, but relies on the Cappa reference as teaching a baffle 40 attached to a cap and positioned above an exhalation port. This combination of references is traversed because Cappa does not teach a baffle location relative to a microphone and Kettle et al in any event does not teach an exhalation port per se. Only conjecture and speculation are provided in the outstanding Office Action as to where an exhalation port in Kettl et al would be provided. It is impermissible under 35 USC §103 to applied isolated teachings and conjecture and speculation to create a hindsight reconstruction of the claimed invention. Further, the rationale for the combination provided in the outstanding Office Action, i.e., "in order to prevent air from penetrating the upper portions of the mask," makes no sense, since no such requirement is evident in either Applicants' disclosure or in Kettl et al. Accordingly, the outstanding rejection of Claim 13 is also traversed and withdrawal thereof is respectfully requested.

BEST AVAILABLE COPY

Consequently, in light of the above discussion, it is respectfully submitted that Claims 10-18 patentably define over the cited prior art and are in condition for allowance. An early and favorable action to that effect is respectfully requested.

Finally, the attention of the Patent Office is directed to the change of address of Applicants' representative, effective January 6, 2003:

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314

Please direct all future communication to this new address.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Attorney of Record  
Registration No. 25,599  
Eckhard H. Kuesters  
Registration No. 34,423



**22850**

(703) 413-3000  
Fax No. (703) 413-2220  
EHK/mlh  
I:\atty\EHK\Amend-Responses\208822US.req for reconn after final.wpd